

REMARKS

Reconsideration is requested.

Claims 54, 56-58, 60-76, 78-80 and 82-96 are pending. Claims 64-69, 73, 74, 85-91, 95 and 96 have been withdrawn from consideration.

Rejoinder and allowance of any claim defining a method of making and/or using a product defined by an allowable claim, at an appropriate time, are requested.

A Decision on the applicants Petition of October 25, 2007 is again requested

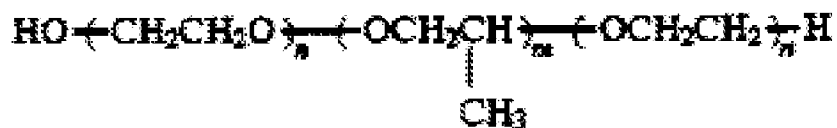
The Section 102 rejection of claims 54, 56-58, 60-62, 71, 75, 76, 78-80, 82-84, and 93 over Nakatsu et al (U.S. Patent No. 6,790,269) is traversed. Reconsideration and withdrawal of the rejection are requested in view of the fact that the present application was filed in the U.S. on September 23, 2003 and the cited patent is only available as a reference under Section 102(b) as of September 14, 2004 (i.e., the date of issuance of the patent). The cited patent was filed in the U.S. on April 28, 2003, according to the face of the patent. The present application however claims benefit of P2002-271696 and P2002-332751, filed in Japan on September 18, 2002 and November 15, 2002, respectively. Certified copies of the priority documents are contained in the PTO IFW. Certified English language translations of the priority documents are being filed concurrently herewith. The BIBDATASHEET contained in the PTO IFW on September 23, 2004 confirms that the applicants have claimed priority and that the conditions of 35 USC 119 have been met.

Withdrawal of the Section 102(b) rejection of claims 54, 56-58, 60-62, 71, 75, 76, 78-80, 82-84, and 93 over Nakatsu et al is requested.

The Section 103 rejection of claims 63, 70, 72, 75, 85 and 92-94 over Nakatsu et al in view of Santilli (U.S. Patent No. 5,738,716) is traversed. Reconsideration and withdrawal of the rejections are requested in view of the above and the following distinguishing comments.

Nakatsu et al is not citable against the present claims for the reasons noted above. Santilli alone fails to teach or suggest the claimed invention. The Examiner has not cited Santilli alone or established a *prima facie* case of obviousness of the rejected claims based on Santilli alone. Withdrawal of the Section 103 rejection is requested.

The Examiner asserts, as a basis for the rejection over Santilli, that the cited patent teaches an ink composition comprising water and a surfactant of the following formula:



.¹ The Examiner admits on page 7 of the Office Action dated December 26, 2008 that "The reference fails to teach the specific formula set forth by structures V and XIII."

The Examiner is requested to appreciate that the structures of formulas V and XIII of the claims do not include the branched structure (iso-propylene) of the cited patent. In the case of the noted structure of Santilli, the structures of the claims do not include the peroxide (–O–O–) bond of the cited art. The Examiner's reliance on the structure of the surfactant of the cited patent as a basis for allegedly establishing a

prima facie case for obviousness therefore is misplaced. The Examiner has not established that in the generally unpredictable chemical arts the structures of the cited art would provide the required relationship of the claims (i.e., the following relationship (1):

$$0 \leq [\text{dynamic surface tension (mN/m)}] - [\text{static surface tension (mN/m)}] \leq 7 \text{ (mN/m) (1)}.$$

The applicants submit that the inclusion of a branched structure in the cited art will provide a different conformational, three-dimensional structure of the compounds and thus significantly affect the physical properties of the compounds, including polarity. The applicants believe therefore that the physical and chemical characteristics, such as the surface tension, of the compounds are unpredictable from a review of the structures alone. There is no evidence of record to demonstrate the surfactants of Santilli have the same or similar surface tension as that of the surfactant of formulas (V) or (XIII) of the present claims.

The Examiner has asserted that the similar structure of the surfactants alone, with a similarity in the pigments and static surface tensions, allegedly establishes a *prima facie* case of obviousness. The Examiner asserts that

if the static surface tension is achieved with a surfactant claimed by Applicant that the composition would obviously have a similar dynamic surface tension to yield the difference of surface tension, absent tangible evidence to the contrary.²

The Examiner further admits that

¹ See page 6 of the Office Action dated December 26, 2008.

² See page 5 of the Office Action dated December 26, 2008.

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The reference remains silent to the difference of surface tensions.³

The Examiner has not mentioned in the Office Action of April 28, 2009 the Examiner's previous reliance on In re Merck 231 USPQ 375 (Fed. Cir. 1996) for an assertion that a *prima facie* case of obviousness may be established "for chemical compositions ... by showing structural similarity in combination with similar chemical properties."⁴ The applicants remarks of February 25, 2009 in this regard are presumed to have been persuasive.

Withdrawal of the Section 103 rejections is requested.

The claims are submitted to be in condition for allowance and a Notice to that effect is requested. The Examiner is requested to contact the undersigned, preferably by telephone, in the event anything further is required.

Respectfully submitted,

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³ See page 5 of the Office Action dated April 28, 2009.

⁴ See pages 5 and 7 of the Office Action dated December 26, 2008.